REMARKS

Applicants respectfully request favorable reconsideration of the above-captioned application.

In response to the Office Action dated December 20, 2005, Applicants timely filed an Amendment on April 18, 2006. Because the Advisory Action dated May 1, 2006 does not expressly state that this Amendment after a Final Office Action was entered, Applicants believe that the Amendment of April 18, 2006 was not entered. Moreover, the Amendment of April 18, 2006 is not indicated as being resubmitted on the RCE. Therefore, as indicated below, Applicants' response below should be taken as a substitute response for the Amendment of April 18, 2006. One consequence of this is that the renumbering of the claims, as discussed below, is only now being performed, and therefore it is correct to identify claims 82-86 in the above list of claims as "new" claims, rather than "previously presented" claims.

This application has been carefully reviewed in light of both the Office Action dated December 20, 2005 and the Examiner's comments in the Advisory Action of May 1, 2006.

In the Office Action of December 20, 2005, the Examiner kindly pointed out that claim 76 was inadvertently omitted, and required appropriate correction. Therefore, in this Amendment, claims 77-81 have been cancelled without prejudice and claims 82-86 have been substituted therefore. Claims 82-86 are identical to cancelled claims 77-81 except for the claim numbers, and the dependencies have been correspondingly addressed.

Therefore, claims 41-75 and 82-86 are now pending in this application. Claims 41 and 60 are independent.

In the Office Action, claims 51-58 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. In particular, these claims recite "Investor/Goal Manager" and

"Profile/Asset" screens, the nature of which is alleged to be unclear. Similarly, claims 72-74 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite as reciting an "Investor/Goal Manager" screen, the nature of which is alleged to be unclear. In the Advisory Action, the Examiner further explained that the indefiniteness arose from the forward slash ("/") in the cited terms, which might be interpreted as indicating alternatives.

Applicants thank the Examiner for this explanation. In accordance therewith, Applicants have amended claims 51-53, 72 and 73, in which the objected-to terms appear, to simplify the names of the screens so as not to use a forward slash. Of course, the screens themselves are not changed by this name change, and they are fully described in the specification and drawings. It is noted that claims 54-58 and 74 did not contain the objected-to terms, but merely depended from claims that did.

Accordingly, Applicants respectfully submit that amended claims 52-58 and 72-74 are proper under Section 112, second paragraph, and the Examiner is respectfully requested to withdraw this rejection.

In the Office Action of December 20, 2005 (herinafter the "Office Action"), independent claims 41 and 62, together with various dependent claims, were rejected under 35 U.S.C. 103 over U.S. Patent 5,918,217 (Maggioncalda et al.) in view of US 2003/0208427 (Peters et al.). Others of the dependent claims were rejected as being obvious over Maggioncalda et al. and Peters et al. U.S. Patent 6,430,542 (Moran).

As shown above, Applicants have amended independent claims 41 and 62 in light certain comments in the Advisory Action. Support for the amendments may be found, for example, at Paragraph 111, page 22.

Applicants respectfully submit that amended independent claims 41 and 62, which are

corresponding system and method claims, are patentably distinct from the cited prior art for the following reasons.

Much of the following argument was presented in the (unentered) Amendment of April 18, 2006, and is being repeated herein for purposes of the record. However, Applicants have amplified the argument to address the issues raised by the Advisory Action of May 1, 2005 (hereinafter the "Advisory Action") and the amendments to independent claims 41 and 62.

The Office Action cites to Maggioncalda, primarily as to certain physical structures recited in claim 41, such as a front-end including a plurality of graphical user interfaces and a back-end configured to identify one or more recommended investments and an allocation of funds. The Advisory Action further cites to Col. 17, lines 9-16 as disclosing "an adjustable target allocation screen" and to Col. 17, lines 16-33 as disclosing "risk allocation." Without conceding that Maggioncalda actually does disclose all the *physical structures* that the Office Action proposed, Applicants wish first to address those aspects of prior claim 41 that the Office Action alleges are disclosed by Peters.

Amended claim 41 recites, *inter alia*, that (emphasis added):

> "the front-end displays on a graphical user interface a current allocation of the at least one investor account among the plurality of investments, the risk allocation of the at least one investor account among the plurality of investments, an *adjustable* target allocation of the at least one investor account among the plurality of investments and the designated goal, wherein the target allocation is an allocation of the at least one investor account among the plurality of investments chosen by the user."

In other words, amended claim 41 *requires* the display of *three different* allocations:

(1) a current allocation of the at least one investor account among the plurality of investments;

(2) the risk allocation of the at least one investor account among the plurality of

investments; and

(3) an *adjustable* target allocation of the at least one investor account among the plurality of investments.

These three *different* allocations are shown, for example, in Figure 10 (i.e., the second, third and fourth columns in the array 1004).

The present invention as defined in amended independent claim 62 is directed to a method corresponding to the system of amended claim 41 and includes corresponding distinguishing recitations.

SUMMARY OF ARGUMENT

To summarize Applicants' argument, it is believed that the Office Action/Advisory Action together are arguing that the cited combination of prior art discloses each of these three different allocations, and further that one piece of prior art (*Peters*) discloses that two of these allocations (the current allocation and the risk profile allocation) may be displayed on one screen, and that another piece of prior art (*Maggioncalda*) discloses that an adjustable target allocation may be displayed on its own screen. For the purpose of this paper only, Applicants will assume that the cited prior art includes these disclosures.

However, Applicants do not understand the Office Action/Advisory Action to be arguing that any one piece of prior art discloses a *single* screen displaying all *three* allocations, as recited in Applicants' independent claims 41 and 62.

Moreover, as will be discussed further below, Applicants do not understand the Office Action/Advisory Action to be arguing that the cited combination of prior art suggests *combining* the screens in such a way as to display *all three allocations on a single screen*, as recited in Applicants' independent claims 41 and 62. Indeed, Applicants have found no such suggestion in

the cited prior art, as discussed further below.

Rather, it appears that the Office Action/Advisory Action is arguing that two of the three allocations recited in Applicants' prior claims 41 and 62 (the risk profile allocation and the target allocation) are actually the same, and therefore only one of them needs to be displayed, as in Peters.

Particularly in view of the amendments to claims 41 and 62, Applicants respectfully disagree.

In the particular example of Figure 10, the risk profile allocation and the target allocation have the same values, because the investor's risk and investment profile have already been analyzed and formulated, so that the Advisor enables the user to select an asset allocation directed towards specific goal objectives (see Paragraph 111, page 22). Paragraph 111 expressly states that this Allocation Strategies screen 1000 (emphasis added):

> "displays data indicating an investor's goal value by asset class according to current allocation, risk profile allocation and the ***adjustable*** investor target allocation in either percentage or dollar values."

The Advisory Action states that:

> "Applicant argues description of an adjustable investor target allocation at page 16, which is understood as distinct from risk allocation. The claim language does not recite that the target [sic] allocation is adjustable; Applicant argues elements of the specification only."

Applicants respectfully note that the claim terms must be interpreted in view of the specification. In the portion cited above, the specification expressly states that the investor target allocation is adjustable. However, in order to clarify this issue, Applicants have now amended independent claims 41 and 62 to expressly recite that the target allocation is *adjustable*. This amendment is, of course, supported by at least the above-quoted portion of the specification.

Thus these three allocations represent different data, and in particular there is no reason to assume that the risk profile allocation and the ***adjustable*** investor target allocation are the same information.

The Office Action did argue that these two allocations are the same. Specifically, at page 4, the Office Action states (emphasis added):

> "Given that the Applicant's specification and drawings show that the risk profile allocation and target allocation are ***identical*** (See Fig. 14 of instant application), both read as the target allocation (Suggested Holdings", Fig. 18 of *Peters*). This is a logical understanding, as one would want the target allocation to be a reflection of the allocation resulting from the users specified risk tolerance, one would want a target to reflect the desired risk."

As a first point, Applicants believe that the clarifying amendments to claims 41 and 62 that the target allocation is adjustable removes this "understanding" as a reasonable interpretation of the claims. As explained in the portion of *Maggioncalda* cited in the Advisory Action as allegedly disclosing an adjustable target allocation (col. 17, lines 9-16), a user may "express his/her utility function by modifying the recommended allocation provided by the system." This need not have anything to do with the risk allocation that the user is willing to bear.

Assuming, on the other hand, that the Examiner will now maintain that a risk profile and an *adjustable* target allocation are the same, Applicants understand the Office Action to be admitting that Peters discloses in Fig. 18 only two allocations, not the three allocations recited in claim 41, and therefore seeks to read one of the three allocations recited in claim 41 out of the claim. Applicants strongly disagree with this analysis. First, there is absolutely no basis in patent law for reading an entire limitation out of a claim. If the Examiner is aware of any authority to the contrary, he is respectfully requested to identify it.

Second, Applicants specification and drawings do **not** show that risk profile allocation and target allocation are identical. A user may be willing to tolerate certain risks in order to

reach certain target goals, and the allocations of investments may have to be adjusted and/or risks and goals re-evaluated in order to reach a current allocation that seems to be the best compromise at the moment, but that does not mean that these allocations are inherently identical. What the Examiner appears to be doing is looking at the final result, i.e., the ultimate current allocation that is the best compromise, and assuming that because the best compromise was desired from the start, it was also known from the start. To the contrary, these allocations represent different parts of the puzzle and are used together, in accordance with the present invention, to achieve the highly advantageous result described in the specification.

Applicants submit that amended independent claims 41 and 62 expressly recite the display of three allocations, described in different terms having different meanings. Applicants submit that it is improper claim analysis to state that two of these allocations, *expressly defined in different terms*, must be identical and therefore can be read onto a single element of a reference.

Applicants further submit that there is nothing in the references to *Maggioncalda et al.* and *Moran*, taken individually or in combination, to remedy the above described deficiencies of Peters in failing to teach or suggest the output display of three allocations, in context with the remaining claim features, as recited in claim 41. Applicants have reviewed the remaining prior art of record and have found nothing therein that would remedy the deficiencies of *Peters, Maggioncalda et al.* and *Moran* as references against claim 41.

Applicants further submit that there is nothing in the references, taken individually or together, that would teach or suggest *combining* screens from *Peters* and *Maggioncalda et al.* to produce a *single* screen displaying the *three different allocations*, as recited in independent claims 41 and 62. Neither the Office Action nor the Advisory Action suggest that the prior art

teaches a reason to modify these references to meet independent claims 41 and 62, at least as now amended. Even if the combination of references is assumed to disclose all three different allocations, as suggested in the Advisory Action, Applicants respectfully submit that there is still no teach or suggestion in the cited prior art to display all three different allocations on a single screen. Rather, the teaching that this single screen display is advantageous comes solely from the present specification, and to rely on that teaching would be the use of impermissible hindsight.

Accordingly, Applicants respectfully submit that independent claims 41 and 62, together with the claims respectively dependent thereon, are patentably distinct from the cited prior art.

In view of the above amendments and remarks, Applicants respectfully submit that claims 41-75 and 82-86 are patentably distinct from the prior art of record. The Examiner is respectfully requested to pass this case to issue.

If any fee is due for this filing, please charge the LARGE ENTITY fee therefor to Deposit Account No. 16-2500 of the undersigned.

Applicants' undersigned attorney may be reached by telephone at (212) 969-3000 or by facsimile at (212) 969-2900. Please direct all correspondence to Customer No. 21890 at the address provided below.

Respectfully submitted
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